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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,797	01/15/2004	Lev Borisovich Nachmanson	3382-66933	6509

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EXAMINER

SILVER, DAVID

ART UNIT PAPER NUMBER

2128

MAIL DATE DELIVERY MODE

09/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/758,797

Applicant(s)

NACHMANSON ET AL.

Examiner

David Silver

Art Unit

2128

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 August 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See continuation sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

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1. Amendment to claim independent 15 requires further search and considerations: "sequences of at least two edge transitions ending at non-deterministic behavior";
2. Amendments to independent claim 7 require further search and consideration as the scope was altered from intended use to positively cited limitations. Furthermore, it appears the language of claim 7 may present new 35 U.S.C. § 112 second paragraph deficiencies.
3. The Instant Application is not currently in condition for allowance.

4. **Background:**

Claims 1-6 and 15-20 stand rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. **Applicants argue:**

5.1 (Regarding claims 1-6) "Executing a program under test in such a manner as to obtain improved testing coverage for software applications that behave non-deterministically goes beyond simply reciting software steps, and produces a useful, tangible, and concrete result--the well-tested program." (Remarks: page 6)

5.2 (Regarding claims 15-20) "The Action rejects claim 15 on the grounds that the claim feature "computer readable medium" is only recited in the preamble and is therefore "not required for the life meaning and vitality of the claim limitations." Applicants respectfully disagree with the Examiner's characterization of the claim and relevant law, and believe that the claim in their previous state satisfied 35 U.S.C. § 101. Nevertheless, applicants have amended claim 15 in an effort to expedite prosecution. Specifically, the "instructions" are now specifically "stored on the computer-readable medium." As the claim now unambiguously is directed to functional subject matter stored on a computer-readable medium, Applicants respectfully submit that claim 15 is directed to statutory subject matter and request that the rejection under 35 U.S.C. § 101 be withdrawn. Claims 16-20 depend on Claim 15 and at least for that reason should also not be subject to a 35 U.S.C. § 101 rejection." (Remarks: page 7)

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6. **Examiner Response:**

6.1 Regarding subsection 1 *supra*, Applicants' arguments have been fully considered but are unpersuasive. The claimed invention merely recites software steps, and does not **produce** a well-tested program. The program was produced before method was performed, therefore the claims do not produce a concrete, useful, and tangible **final** result.

The rejection of claims 1-6 is **maintained**.

6.2 Regarding subsection 2 *supra*, Applicants' amendments are sufficient to overcome the 35 U.S.C. § 101 rejection in view of MPEP 2106.01, which recites, in part: "When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized."

The rejection of claims 15-20 has been **withdrawn**.

7. **Background:**

Claim 13 stand rejected under 35 U.S.C. 112, second paragraph, as being **indefinite** for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13, lacked antecedent basis for "the created strategies".

8. **Applicants argue:**

"[...] Applicants have amended claim 13 in an effort to expedite prosecution, and to provide explicit antecedent basis for the claim 13 language "the created strategies." Applicants respectfully request that the rejection be removed." (Remarks: page 7)

9. **Examiner Response:**


Applicants are thanked for amending the claims in order to overcome the 35 U.S.C. § 112 P2 deficiency.

Rejection **withdrawn**.

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10. Applicants' arguments regarding the 35 U.S.C. § 102 rejection are lengthy, complex, and raise new issues that require further consideration and/or search.

11. The Instant Application is not currently in condition for allowance.


KAMINI SHAH
SUPERVISORY PATENT EXAMINER